

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Swart, et al.

Serial No.: 09/920,615

Confirmation No.: 6958

Filed: August 3, 2001

For: VIDEO AND DIGITAL  
MULTIMEDIA AGGREGATOR REMOTE  
CONTENT CRAWLER

§ Case Number: SEDN/5312

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§ Group Art Unit: 2169

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§ Examiner: Betit, Jacob F.

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MAIL STOP – Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir or Madam:

**REPLY BRIEF**

Appellants submit this Reply Brief to the Board of Patent Appeals and Interferences in response to the Examiner's Answer dated November 7, 2008 in the Appeal of the above-identified application.

### **REMARKS**

In Section 10 of The Examiner's Answer (Response to Arguments), the Examiner asserts that the limitation "a crawler content provider processor that receives, processes and stores content provider listings such that a subscriber obtains desired content via tuning a set top terminal to a television channel carrying said desired content" recites optional limitations under MPEP §2106. In addition, the Examiner raises various questions regarding the Appellants' invention.

Contrary to the Examiner's assertion, the Appellants respectfully submit that the limitation of "a crawler content provider processor that receives, processes and stores content provider listings such that a subscriber obtains desired content via tuning a set top terminal to a television channel carrying said desired content" does not recite any optional limitations under MPEP § 2106. The Appellants submit that the Examiner failed to identify specific language that makes the above limitation optional. The MPEP at § 2106 provides examples (e.g., 1) statements of intended use or field of use, 2) "adapted to" or "adapted for" clauses, 3) "wherein" clauses, or 4) "whereby" clauses). The Appellants direct the Boards attention to the fact that the above limitation fails to recite language that allows the above limitation to be optional.

More appropriately for rejections under 35 U.S.C. § 103, the MPEP §2143.03 clearly states that for rejections under obviousness that "all words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)(emphasis added). The Appellants submit that the independent claims are clearly written to require that content from a crawler content provider is obtained via tuning a set top terminal to a television channel carrying said desired content. The Appellants have clearly argued why the combination of the prior provided by the Examiner fails to render the Appellants' independent claims obvious under 35 U.S.C. § 103 in the submitted appeal brief.

Moreover, the Examiner continues to highlight various examples illustrated in the Appellants' specification to support the Examiner's position. However, the Appellants respectfully submit that the independent claims only claim an embodiment where the content must be obtained or provided via tuning a set top terminal to a television channel carrying said desired content. In other words, the Appellants submit that the

independent claims are amended and written as to exclude the various embodiments highlighted by the Examiner.


The Appellants also note that the Examiner raises various questions regarding the Appellants claims. (See Examiner Reply, p. 19, l. 17 – p. 20, l. 12). The Appellants submit that the questions raised by the Examiner are irrelevant to the issue of obviousness under 35 U.S.C. § 103.

Therefore, for the reasons submitted above and the arguments submitted in the Appellants' appeal brief the Appellants contend that the Examiner failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103. Therefore, the Appellants respectfully request the Board to reverse the Examiner's rejection of all claims.

### CONCLUSION

Appellants respectfully request that the Board reverse the rejections and pass the claims to allowance.

Respectfully submitted,



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